

REMARKS

Claims 1-23 are pending in the present application. The Office Action Made Final mailed April 22, 2005 ("the Final Rejection") maintains rejections with respect to claims 1-23.

Attorney Docket Number

Applicant would greatly appreciate it if the Examiner would consider changing the attorney docket number from "WIDC-024/00US" to "15981US01".

Correspondence Address

The Final Rejection was mistakenly sent to "Kevin J. Zimmer, Cooley Godward LLP, Five Palo Alto Square, 3000 El Camino Real, Palo Alto, CA 94306-2155". On September 9, 2004, a Power of Attorney By Assignee of Entire Interest, a Revocation of Prior Powers and a Change of Correspondence was filed in the present application. A Notice of Acceptance of Power of Attorney ("the Notice") was mailed on April 26, 2005. A copy of the Notice is enclosed herewith.

In view of the Notice, kindly address future correspondence to:

Christopher C. Winslade
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500 West Madison Street, Suite 3400
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Dictionary

In support of the rejections, the Examiner alleges that a dictionary, in particular a Merriam Webster's Collegiate Dictionary, states that random means in any order the user desires.

Applicant does not question the Examiner's integrity. However, Applicant respectfully is skeptical that the definition of random in said dictionary at all references *a user* or *the desire of said user*. Applicant respectfully cautions the Examiner that Applicant cannot possibly judge

said dictionary on the merits since the Examiner failed to provide Applicant with a copy of said dictionary or at least the relevant pages of said dictionary.

Applicant respectfully requests that the Examiner provide, *for the first time*, Applicant with a copy of this non-patent literature document. Applicant will also need to view the publication date of said dictionary to determine whether the non-patent literature document is indeed prior art. Applicant respectfully submits that it is essential that Applicant see the plurality of definitions that were viewed by the Examiner and the exact definition chosen by the Examiner. Applicant respectfully requests that the Examiner provide a reason in support of one definition over the other definitions. In addition, Applicant needs to know which part of the chosen definition is from the dictionary and which part of the chosen definition was added by the Examiner.

Applicant respectfully submit that a full and fair hearing has not been provided since the Examiner did not provide a copy of the non-patent literature document with a publication date to Applicant.

Applicant respectfully requests that the Examiner provide Applicant with a copy of the relevant definition, in full, and a copy of the publication information for said dictionary. Since Applicant does not have said copies, Applicant is unable to determine, on the merits, whether the use of the non-patent literature document and the characterization of the definition of random on which the Examiner relies is proper.

In addition, Applicant respectfully requests that the Examiner issue a new office action made final with new statutory deadlines so that Applicant may fully and fairly examine the non-patent literature document for the *first time*.

Anticipation Rejection

Claims 1-9, 13-17 and 20-23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by United States Publication No. 2001/0019956 ("Tada"). Applicant respectfully traverses the rejection.

Claims 7-9: Inquiries

Independent claim 7 recites, in part, "performing inquiries at random intervals". Generally, "Inquiry is periodically performed to acquire information about terminals within the communication zone in advance". Tada at paragraph [0077]. Tada does state that, under a

particular circumstance, "the current mode is changed to a mode of stopping periodical transmission of Inquiry and issuing Inquiry only when an application or user requests the establishment of a new radio link in order to prevent communication performance from deteriorating due to Inquiry".

Applicant respectfully submits that "issuing Inquiry only when an application or user requests ... to prevent communication performance from deteriorate due to Inquiry" does not describe "performing inquiries at random intervals".

First, to be clear, Tada is silent as to "performing inquiries at random intervals". Instead, the Examiner has alleged, without document support, that "[t]he user manually performs Inquiries at his own desire" and that "performing ... at his own desire" must necessarily be at random intervals. Since there is no support in Tada for any user, at his own desire, performing inquiries at random intervals, the anticipation rejection cannot be maintained.

Each and every element as set forth in claim 7 must be described in Tada to maintain an anticipation rejection. There is no dispute that Tada does not describe "performing inquiries at random intervals" and there is no dispute that Tada does not describe the desire of users to perform inquiries at random intervals. The Examiner has merely alleged (or assumed) with no documentary support for such assertion that the desire of users is to perform inquiries at random intervals.

Applicant respectfully submits that the Examiner must be applying the doctrine of inherency. In other words, the Examiner must be alleging (for the first time) that a user's desire to perform inquiries at random intervals is inherent to a user's desire.

Applicant respectfully submits that the doctrine of inherency does not apply in this case in which an allegedly random interval of performing inquiries according to a user's desire (which is not supported by Tada) is only a possible, but not necessary, outcome for performing inquiries according to a user's desire.

The United States Court of Appeals for the Federal Circuit ("the Federal Circuit), whose case law is binding on the United States Patent and Trademark Office, has stated that

anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must *necessarily* include the unstated limitation

Transclean Corp. V. Bridgewood Services, Inc, 290 F.3d 1364, 1373, 62 U.S.P.Q. 2d 1865 (Fed. Cir. 2002). The Federal Circuit has also held that

[i]nherency does not embrace probabilities or possibilities

and that

[i]nherent anticipation requires that the missing descriptive material is "necessarily present," not merely probably or possibly present, in the prior art.

Trintec Indus., Inc. V. Top-U.S.A. Corp, 295 F.3d 1292, 1297, 63 U.S.P.Q. 2d 1597 (Fed. Cir. 2002).

Thus, since the inherency doctrine is inapplicable here, there is no basis for maintaining the anticipation rejection with respect to claim 7 and its dependent claims 8 and 9.

Claims 13-17: Inquiries

Independent claim 13 recites, in part, "performing first inquiries at random intervals" and "performing second inquiries at random intervals". Since the claim language of independent claim 13 is very similar to the claim language of independent claim 7, Applicant respectfully makes the same or similar arguments, if appropriate, with respect to claim 13 as were made with respect to claim 7.

For at least the above reasons, the anticipation rejection cannot be maintained with respect to claim 13 and its dependent claims 14-17.

Claims 20-23: Inquires

Independent claim 20 recites, in part, "performing inquiries at random intervals". Since the claim language of independent claim 20 is very similar to the claim language of independent claim 7, Applicant respectfully makes the same or similar arguments, if appropriate, with respect to claim 20 as were made with respect to claim 7.

For at least the above reasons, the anticipation rejection cannot be maintained with respect to claim 20 and its dependent claims 21-23.

Claims 1-6: Inquiry Scan

Independent claim 1 recites, in part, "performing an inquiry scan for a random duration following said inquiry". In section that allegedly describes at least these elements, which is paragraphs [0084] to [0093] and is entitled "[0084] Second example of Optimization of Parameters for Connection Control". There is no support in the example given for performing the inquiry scan manually by the user following the inquiry. The user is located at the device that is performing Inquiry Scan/Page Scan in order to connect other devices the network used by the user. Thus, in the example described, there is no support for sending an inquiry scan after an

inquiry since the user only clicks on the "member join button" to add a remote device to its network.

In the Final Rejection, the Examiner alleges that "[t]he user manually stops transmission and performs Inquiry scan at his own desire by selecting suitable time interval, therefore, the time interval during which Inquiry scan can be performed is varied or set randomly by the user". The Final Rejection at page 3. However, once again, the Examiner failed to provide documentary support for this statement in Tada. Tada does not describe "performing an inquiry scan for a random duration". The Examiner has merely alleged that it is possible for a user to desire to perform an inquiry scan for a random duration. Tada does not describe such a situation and thus Tada fails to anticipate claim 1.

Since "performing an inquiry scan for a random duration" is merely a possible, not necessary, alleged outcome of a user's desire, the inherency doctrine also is not applicable here. Applicant respectfully directs the Examiner to the above discussions with respect to the law relating to the inherency doctrine.

Obviousness Rejection

Claims 10-12, 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being obvious over Tada in view of United States Publication No. 2002/0147027 ("Alford") and further in view of United States Publication No. 2003/0036350 ("Jonsson"). Applicant respectfully traverses the rejection. The failings in the teaching of Tada as set forth above are not made up by the teachings of Alford and Jonsson. For example, none of the alleged references provides a motivation for a user to desire performing inquiries at random intervals. Accordingly, it is respectfully requested that the obviousness rejection be withdrawn respect to claims 10-12, 18 and 19.

Claim 23 stands rejected under 35 U.S.C. § 103(a) as being obvious over Tada in view of Alford. The failings in the teaching of Tada as set forth above are not made up by the teachings of Alford. For example, none of the alleged references provides a motivation for a user to desire performing inquiries at random intervals. Accordingly, it is respectfully requested that the obviousness rejection be withdrawn respect to claim 23.

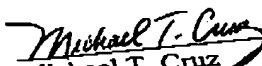
Conclusion

In view of at least the foregoing, it is respectfully submitted that the pending claims 1-23 are in condition for allowance. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the below-listed telephone number.

Please charge any required fees not paid herewith or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Dated: June 22, 2005

Respectfully submitted,


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